

JAN 31 2008

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FAX COVER LETTER

January 30, 2008

TO: Mail Stop Petition
COMPANY: Commissioner of Patents
PHONE: 571-272-8300
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FROM: Christopher R. Hilberg
DIRECT DIAL: 612-607-7237
EMAIL: CHilberg@oppenheimer.com
RE: Serial No. 09/704,838
Filed: November 1, 2000
Our Ref.: 60021-375901

COMMENTS: Attached please find a copy of the Petition Under 37 CFR 1.181 for Withdrawal of
Final Rejection

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JAN 31 2008

P A T E N T

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Petitioners: Ronald E. Sloan et al.

Serial No.: 09/704,838

Filed: November 1, 2000

Title: A User Interface For A Financial
Modeling System

Docket No.: 60021-375901

Group Art Unit: 3693

Examiner: K.S. Apple

Mail Stop Petition
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 C.F.R. 1.181 FOR WITHDRAWAL OF FINAL REJECTION

Dear Sir:

Petitioners request withdrawal of the Final Office Action of November 30, 2007. Additionally, Petitioners request that a new office action that satisfies the requirements of MPEP §706.07 be issued.

Accordingly, this Petition invokes the supervisory authority of the Director of the USPTO under 37 CFR §1.181 for petitions in accordance with MPEP §1002.02(c)(3). Further, MPEP §1002.02(c) indicates that the delegation of such a petition is to the Technology Center Director.

STATEMENT OF FACTS

On July 13, 2007, the Examiner mailed a Office Action for the present application with a non-final rejection of all the pending claims based on, *inter alia*, 35 U.S.C. §103. Petitioners responded to this non-final rejection in a Response and Amendment submitted on September 14, 2007. The amendment changed Claim 1 to add the following underlined limitations:

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1. (Currently amended) A method for providing a graphical user interface to a financial modeling system allowing both live advice and automated coaching comprising:
 - providing a plurality of user selectable service levels for a user to select one of the service levels wherein each service level includes a unique combination of amounts of portfolio modeling and automated coaching available to the user, and wherein each service level includes a selected amount of dialogue and instructions between the user and a live advisor;
 - providing a plurality of icons for selecting at least one of a plurality of methods for communicating with the live advisor over ~~the Internet~~ a network based on the selected service level;
 - providing a first window for displaying an image of said live advisor; ~~and~~
 - providing a second window for displaying context sensitive automated coaching ~~related to~~ determined by the selected service level[[.]] and a user's communication; and
 - providing a communication component for allowing the user to respond to the portfolio modeling and automated coaching of the selected service level, wherein the communication component captures the user's communication which is responsive to the context sensitive automated coaching.

On November 30, 2007, the Examiner mailed an Office Action with a final rejection of all pending claims based on the identical references under 35 U.S.C. §103. The Examiner's basis for the §103 rejection on Pages 2-6 used identical language to that quoted in the previous Office Action, and no changes were made to the Examiner's reasons to reflect the claim amendments. Moreover, the §103 rejection that was restated in the November 30, 2007 Final Office Action did not cite where the references allegedly taught or suggested the new claim limitations.

ACTION REQUESTED

Petitioners request that the Final Office Action of November 30, 2007 be withdrawn, and a new action be provided which complies with the examination requirements of 37 C.F.R. §1.113(b) and MPEP Chapter 700.

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SUPPORT FOR ACTION REQUESTED

37 C.F.R. §1.113(b) states:

In making [a] final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

See also 35 U.S.C. §132(a). Further, MPEP §706.07 provides:

In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection.

Petitioners submit that the Final Office Action of November 30, 2007 does not contain clearly developed grounds of rejection of record to allow Petitioners to readily judge the advisability of an appeal. The grounds relied upon for the final rejection do not provide a basis for rejecting each and every limitation of the presented claims, and thus fail to provide a proper basis for a §103 obviousness rejection as required by MPEP §2143.

Specifically, Petitioners submit that the Final Office Action fails to provide grounds on record for rejecting the newly added "communication component" element under §103. Nowhere in the Final Office Action is the claimed term "communication component" acknowledged or recited, nor were any limitations associated with this communication component addressed. Indeed, the Examiner did not acknowledge the substance of any claim amendment offered in the Petitioner's response.

On Page 6 of the Final Office Action, the Examiner briefly responded to arguments made by the Petitioner in the previous Response and Amendment. Although the Examiner addressed two portions of the Petitioner's arguments, the Examiner failed to provide any statement regarding the applicability of the cited references to amendments within the claims.

Due to the incomplete reasons provided on record in the November 30, 2007 Final Office Action, the Petitioner is not in a position to understand the rationale for the §103 rejection or make an informed judgment about the advisability of appeal. Petitioners respectfully request withdrawal of this Office Action, and the issuance of a new Office Action which fully examines and specifically enumerates the basis for rejecting each and every element of the amended claims.

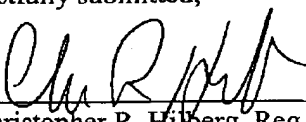
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CONCLUSION

Based on the above information, it is respectfully requested that this Petition under 37 C.F.R. §1.181 should be granted. If any fees are due in connection with the filing of this paper, then the Director is authorized to charge such fees, including fees for any extension of time, to Deposit Account No. 50-1901 (Reference 60021-375901).

Respectfully submitted,

By



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